

REMARKS

The Examiner's remarks have been carefully considered and the prior patents cited and applied have been carefully studied.

Claims 36-41 have been cancelled and Claims 35 and 42 have been amended without any intention of acquiescing as to the pertinency of the prior patents but to more clearly define applicant's invention and to eliminate possible ambiguities.

Claims 35 and 42 are presently in this application.

Applicant is submitting herewith a terminal disclaimer to avoid the rejection on double patenting.

Applicant's invention is directed to a method of making a vial which has an outer straight cylindrical wall and a curved inner cavity. The entire outer wall and the entire inner cavity are formed simultaneously in a single step. The inner cavity is in the form of a substantially uniform arc which is bent in one direction toward the outer cylindrical wall of the vial. The vial has an open end and a closed end. The closed end and the open end are both at right angles to the cylindrical outer wall. This facilitates proper insertion of the vial in a level. All the features of

the vial are formed simultaneously in a single step. This insures that all the vials formed by this method are identical to each other --- which would not be the case if the vial were formed in separate steps.

Amended Claims 35 and 42 are directed to this invention which is neither anticipated by any of the prior patents nor rendered obvious by the prior patents either alone or in combination with each other.

Wright Patent No. 5,003,699 discloses a vial in which the internal cavity is not an arc which is uniform in cross-section throughout its length. The inner cavity is oblong and balloon shaped. This is quite different from applicant's vial in which the internal cavity is an arch which is uniform in cross section and is bent toward one of the cylindrical side walls. Nothing in this patent discloses any method of making the vial. Hence, this patent does not anticipate.

Our Patent No. 5,595,518 is directed to the manufacture of a fin device for water sports. This patent has nothing to do with applicant's vials.

In the first place this patent relates to the manufacture of a fin device for water sports and is totally non-analogous art. Applicant submits that this reference should not be used in determining patentability of applicant's invention. Applicant's invention is directed to a

carpenter's level. The fin device of the cited reference is directed to a sporting device and has nothing to do with levels. Applicant submits that experts knowledgeable in the art of carpenter levels would not look to sporting devices for ideas. Applicant's invention is manifestly far removed from the art of manufacturing fin devices. Hence, it is improbable that someone seeking to improve carpenter's levels would turn to the winter sports fin device art. Applicant submits that this reference is non-analogous and should not be used in determining patentability of applicant's invention. The case of *In re: Van Wanderham* 154 USPQ 20 (CCPA 1967) held that cavitation problems are quite different from the art of manufacturing cutlery and held that the two arts are nonanalogous. Applicant submits that the same principle applies in this situation and that the fin device art is quite different from the carpenter level art. Hence, this reference should not be used in determining applicant's invention.

In the second place, this patent does not disclose simultaneous formation of a fin device. The portions 5 and 2 of the fin device are first formed separately and these are then placed in a mold and thereafter the portion 10 is formed by injection molding. Hence, this patent discloses several steps and not a single step. Moreover, the portion 10 which is injected into the mold does not form the entire outer surface of the fin since previously prepared portions 5 and 2 form parts

of the outer surface. This is quite different from applicant's method in which the entire outer surface and the entire inner cavity as well as the open end and the closed end are all formed simultaneously in a single step. Hence, this patent neither anticipates nor renders applicant's invention obvious.

In the third place, the resulting fin device is totally different from applicant's finished vial and none of the features of applicant's vial.

SE148,436 discloses a vial in which the closed end is not perpendicular to the straight side walls. There is nothing in this patent to suggest the entire outer wall as well as the entire inner cavity are made simultaneously in a single step. This patent does not disclose how the vial is formed. It is possible that the inner cavity of this vial is not formed simultaneously with the outer wall but formed separately. Moreover, the closed end wall of this vial is not formed at right angles to the outer wall as it is in applicant's invention so that proper placement of the vial in a level is much more difficult with the vial of the reference than it is when the vial is made with applicant's method. Hence, this patent does not anticipate nor render applicant's invention obvious.

The Examiner has combined the Wright and Our patents and has rejected the claims as

being obvious over the combination. Applicant submits that the combination of these references would not render applicant's invention obvious. Still lacking from the combined references would be any suggestion in any of these patents that the entire inner cavity and the entire cylindrical outer wall is formed simultaneously in a single step. Wright and Our do not disclose this. As indicated above Our's method comprises many steps. In addition, as indicated above, the Our patent is non-analogous art and should not be used to reject the claims. Applicant submits that the Examiner has not specified any teaching motivation or suggestion in the references for combining them. The Examiner has not explained why one of the ordinary skill of the art would be motivated to select one of the references and combine it with others to render the claimed invention obvious. This explanation has been required by the CAFC. *In re Lee 61 USPQ2d 1430 (CAFC 2002).*

The Examiner has stated that the steps will be met during the normal manufacturing process of the device stated above. However, the examiner has not stated how the steps will be met and what manufacturing process the Examiner has in mind. Nothing in Wright suggest the method of simultaneously forming the various parts of the vial. The vial in this patent may be formed in separate steps. Our discloses forming the various parts of the fin device in several

steps and not simultaneously in a single step as required by the claims. Hence, applicant does not know what manufacturing process the Examiner has in mind. The Examiner should indicate how the steps of the invention would be met by the normal manufacturing process. But the Examiner has not done so. The Examiner is asserting general knowledge to reject the claims on the ground of obviousness but the Examiner must articulate that knowledge and place it on the record as required by the Courts. *In re Lee*, 61 USPQ 2nd 1430 (CAFC 2002). The Examiner has not done so in this case. Hence, applicant submits that combination of these references do not render the invention obvious.

The Examiner has also combined the Wright, Our and SE patents and has rejected the claims as being obvious over the combination of references. Applicant submits that the combination of these references would not render applicant's invention obvious. Still lacking from the combined references would be any suggestion in any of these patents that the entire inner cavity and the entire cylindrical outer wall is formed simultaneously in a single step.

Neither Wright, Our nor SE disclose these steps. Our's method comprises many steps. In addition, as indicated above, Our Patent No. 5,595,518 is non-analogous art and cannot be used to reject the claims.

Applicant submits that the Examiner has not specified any teaching motivation or suggestion in the references for combining them. The Examiner has not explained why one of the ordinary skill of the art would be motivated to select one of the references and combine it with others to render the claimed invention obvious. This has been required by the Courts. *In re Lee* 61 USPQ2d 1430 (CAFC 2002).

The Examiner has stated that the steps will be met during the normal manufacturing process of the device stated above. However, the examiner has not stated how the steps will be met and what manufacturing process the Examiner has in mind. Nothing in Wright or SE suggests the method of simultaneously forming the various parts of the vial. The vials in these patents may be formed in several steps. Our discloses forming the various parts of the fin device in several steps and not simultaneously as required by the claims. Hence, applicant does not know what manufacturing process the Examiner has in mind. The Examiner should indicate how the normal manufacturing process of the device would meet the method steps of the invention. But the Examiner has not done so. The Examiner has asserted general knowledge to reject the claims on the ground of obviousness but the Examiner must articulate that knowledge and place it on the record as required by the CAFC. *In re Lee*, 61 USPQ 2nd 1430 (CAFC 2002). The

Examiner has not done so in this case. Hence, applicant submits that combination of these references do not render the invention obvious.

Since none of the prior patents alone or in connection with each other anticipate applicant's invention or render it obvious, allowance of the application is respectfully requested.

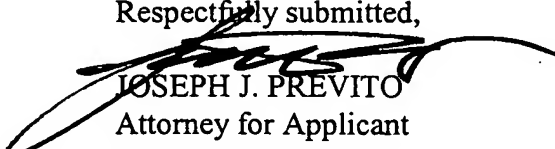
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I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Alexandria, VA 22303-1450, on December 1, 2004.



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Respectfully submitted,



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